

REMARKS/ARGUMENTS

This Amendment and Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

Cancelled: None;

Amended: 1, 11, 24 and 35;

Added: None; and

Currently outstanding: 1-10, 11-20, 21-23, 24-34, 35-45, and 46-48.

No new matter has been added to the application.

From the outstanding Office action, Claims 1-3, 5-14, 17-26, 28-38 and 41-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Day '051 patent. Claims 4, 15, 16, 27, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over further consideration of the Day '015 patent.

The Examiner and Applicant's attorney conducted a plurality of telephonic interviews with regards to the claims in the Examiners rejections. No agreement was reached, but the Examiner's attention to Applicant's claims is gratefully acknowledged as the substance of those conversations has led to greater understanding of the Examiner's viewpoint and, as indicated below, potential reasons for enabling allowance of the claims as amended.

Reconsideration of the Examiner's rejections is respectfully requested.

Applicant has amended the claims to reflect a better indication of the source of the data stream selected according to a selection method. There may have been some ambiguity in the mind of the Examiner with respect to this, and as set forth in greater detail below, the addition

of the indication that the “selecting a data stream” step is one of the selecting of a data stream from “said database” is inherent in the claims as they currently stand. Consequently, no narrowing amendment to conform a statute has been made in the application by the amendments to the claims.

Applicant here explains claim 1 below with an understanding that such explanation will also apply to the other independent claims particularly claims 11, 24, and 35.

Claim 1

The first two elements in claim 1 for the broadcasting method has the method providing a database of data streams and selecting a data stream from said database according to a selection method. The claim that continues with “transmitting one of said data streams to the user’s computer.” The term “one of said data streams” should not be read as necessarily transmitting the selected data stream from the “selecting a data stream” method instead, the antecedent to “said data streams” in this step must arise from the first clause of “providing a database of said data streams.”

This is an important distinction as the Examiner may have considered the transmission of one of said data streams to be the transmission of the data stream arising from the step of “selecting a data stream.” As set forth in more detail below, Applicant’s claim 1 generally does not allow for this.

Once transmission has occurred of one of the data streams from the database, the broadcasting method includes “receiving feedback expressing a preference from the user regarding said transmitted data stream.” As indicated above, the transmitted data stream is one from the database of data streams. Note should be taken of the term “feedback,” a definition

of which as included herein as Exhibit 1. The term “feedback” has to do with the “transmission of evaluative or corrective information to the original or controlling source about an action, event, or process” as well as the “information so transmitted.” Exhibit 1, definition 2B.

As a result, feedback can only occur when the transmitted data stream has been received by the user, and is not merely an instruction that occurs prior to the transmission of data streams. Instead, an ongoing and interactive process is set forth in claim 1 that requires feedback regarding the transmitted data stream.

The broadcasting method in claim 1 then has the step of “updating said selection method to better reflect said preference of the user.” Note should be taken here with regards to the terms “said preference” and “said selection method.” The preference indicated in this clause relates back to the preference expressed by the user regarding the feedback directed towards the transmitted data stream. Careful note should be taken with regards to “said selection method” as this clause then relates back to the second clause with regards to the step of “selecting a data stream according to a selection method.” “Said selection method” is the selection method that is used to select a data stream in the second step of claim 1. This selection method is updated to better reflect the preference expressed in step 4 of claim 1 with regards to the user’s feedback. The initial five steps of claim 1 then result in clause 6 where “data streams transmitted to the user are biased according to said preference.”

As the only data streams transmitted to the user are those of the database, the term “data streams” of clause 6 are those arising from that database of step 1. The biasing of the data streams is achieved via the selection method that is updated according to the user’s

feedback preference. As the biasing of the data streams occurs via the selection method and as the selection method is used in the step of “selecting a data stream” of step 2, the data stream selected in step 2 must be from the database of data streams set forth in step 1.

As a result, the amendatory language “from said database” set forth in step 2 is redundant and what had been implicit in the claim is now made explicit.

As such, Applicant’s claim 1 provides a balanced, coherent, and integrated method by which subject matter not achieved before in the art is set forth with particularity and defines over that which has been achieved before, particularly the Day ‘015 patent.

More particularly, claim 1 is patentable over the Day ‘015 patent in light of the description the Examiner made regarding the rejections based on 35 U.S.C. § 102 and 103.

Discussion of the Examiners’ rejection of claim 1 is set forth below.

The Rejections - §102

Office action, paragraph 3, bullet 1

The Examiner considered the Day ‘015 patent (the Day patent) to disclose the providing of a database of data streams available to a computer network. The Day patent does disclose several programs and method elements in column 5, lines 24-38, but no common database from which the client may select an asset via an HTML page. Instead, what is set forth in column 5, lines 24-38 is the end of a search algorithm and the beginning of a selection algorithm. The selection algorithm also includes an execution algorithm by which media may be transmitted to the user via the client web browser 221 or otherwise.

Office action, paragraph 3, bullet 2

The Examiner indicates that the Day '015 patent teaches or discloses the selecting of a data stream according to a selection method in column 5, lines 7-19 thereof. As far as Applicant can determine, the only data stream selected in the indicated portion of the Day '015 patent are the web pages transferred back and forth between different elements of the system as well as the client web browser 221. In the portion of the Day '015 patent indicated by the Examiner, an HTML page containing links to the presentation formatter program is requested by the client web browser 221 via the VOD presentation formatter. From the returned page, the client web browser selects the search function to initiate a search of the available assets. Upon receipt of the request, the presentation formatter server 207 runs the VOD presentation formatter program which then dynamically creates a search form based on fields (apparently data fields) and the application server content management database 217 then returns the form via the presentation formatter server 207 to the client, apparently via the client web browser 221. The client then completes the search field and sends the data to the presentation formatter server 207.

In the foregoing text, no actual data stream is selected. However, the foregoing apparently indicates the partial portion of a search function in order to determine a potential data stream for transmission.

Office action, paragraph 3, bullet 3

The Examiner relies upon column 5, line 7-19 (the same as above) of the Day '015 patent for the step of transmitting one of said data streams to the user's computer via a data stream controller and user interface including a media player. Applicant has recited above the elements and events set forth in the text cited by the Examiner. Applicant finds no data

streams akin to those present in their application save for the use of signal transmissions for requests and possible acknowledgement as well as the generation and transmission of web pages. If such web pages are considered to be data streams, they are generally static in nature and do not require a media player. While the definition of "data stream" is subject to interpretation, there is generally an element of transience over time with respect to such data streams. This is especially true for media players which stream audio or video information as opposed to just static web pages or other visual displays. In much the same way as a painting is different from a song, a painting is static in time while the song changes over time in melody, orchestration, etc.

Note should be taken, that the web pages present in the recited text are either those from the presentation formatter server 207 that contain links to the presentation formatter program or the dynamically-created search form generated by the VOD formatter. The first of these might be present in a database, possibly one having a single entry, but the latter one from the VOD formatter is created dynamically and so it cannot reside in a database. As a result, while there may be a data stream controller in the form of a different program element disclosed in the Day '015 patent, there generally is no media player and the data streams are not ones selected from the database of available data streams.

Office action, paragraph 3, bullet 4

The Examiner relies upon column 5, lines 7-22 in the Day '015 patent for a step of receiving feedback expressing a preference from the user regarding said transmitted data stream via a user interface which includes a data stream information display. The elements and events of the recited text from lines 7-19 have been set forth above. With regards to lines

19-22, after the client completes the search fields and sends the data to the presentation formatter server 207, the presentation formatter server 207 receives the request and runs the VOD presentation formatter program. The VOD presentation formatter then sends the query to the application server portion 209 of the controller which, in turn, queries the content management database.

The Examiner does not identify which elements of the Day '015 patent correspond to which claim limitations of Applicant. This has led to some significant confusion on the part of Applicant as it is unable to determine exactly which element being asserted by the Examiner as present in the Day '015 patent corresponds to which limitation in Applicant's claims. This presents a very, very difficult question for Applicant as it is unsure as to how to address the Examiner's rejection in a manner that is effective and efficient as it raises confusion, uncertainty, and doubt as to the basis of the rejection

The Examiner may consider such correspondence between elements in the cited patent and limitation in the pending claims to be clear upon mere general indication. Applicant here states for the record that the Examiner's viewpoint is not clear to them as the lack of specificity (with respect to such element-limitation correspondence) creates significant (if not systemic) ambiguity.

Applicant is assuming that the element of receiving feedback, etc, indicated by the Examiner is resident in the additional lines of text, column 5, lines 19-22, as they are not otherwise indicated by the Examiner and as the large number of permutations of possible elements performing duplicate or multiple roles creates an impossible rejection to address as it is not known which elements are performing which functions for which events.

As a result, Applicant assumes that in the Day '015 patent, the client's completion of the search field and transmission of the data to the presentation formatter server 207 constitutes the "receiving feedback expressing a preference from the user regarding said transmitted data stream." Similarly, Applicant is assuming that the client web browser 221 is the "user interface which includes a data stream information display."

Applicant believes these assumptions are valid in that there may be some similarity of function and action with respect to the Day '015 patent and Applicant's claims.

The transmitted data stream set forth in the Day '015 patent in the text cited by the Examiner must be that data stream about which the user is expressing a preference and for which feedback is being received. This is required by Applicant's claims. The only apparent data stream from a database of data streams may be the HTML page containing links to a presentation format or program set forth beginning at line 7 of column 5. That HTML page containing links is apparently the only data stream, or item reasonably similar to a data stream, that arises from the text cited by the Examiner, as set forth above.

However, the feedback transmitted to the presentation formatter server 207 by the client after completing the search field has to do with the dynamically created search form based upon the fields in the application server content management database 217. So, the feedback present in the client-transmitted data is related not to the HTML page containing links to a presentation formatter program but instead is related to the fields in the application server content management database 217, which is not a data stream arising from a database or data streams. Instead, it arises from a dynamically-generated search form created by the VOD formatter.

As a result, and similar to the distinctions in the elements set forth above, Applicant believes that the element recited by the Examiner as far as the step of receiving feedback expressing a preference is not one that is actually present in the Day '015 patent that is sufficiently similar to the subject matter set forth in Applicant's claim 1.

While a preference is expressed by the user, it is not feedback regarding a transmitted data stream from a database of data streams. It is not a data stream because it is a static web page. It is not feedback because the user is expressing a preference with regards to the fields (manifested by the search form), the fields being in the application server content management database. It is not an expression of preference with regards to the form or content of the search form itself, which is the data stream transmitted to the user. Neither is it feedback expressing a preference with regards to the HTML page containing links to a presentation formatter program as there is no opportunity, avenue, or channel to express such a preference as well as there not being any reason to do so. The HTML page containing links to a presentation formatter program simply enables the user via the client web browser 221 to select a search function to initiate a search from available assets.

Office action, paragraph 3, bullet 5

With respect to the step of "updating said selection method," the Examiner relies upon the Day '015 patent and column 5, lines 7-29. Lines 7-22 have been set forth above. Lines 22-29 disclose the VOD presentation formatter sending the query (transmitted by the server 207) to the application server portion 209 of the controller which, in turn, queries the content management database (which may be the same as the application server content management database 217). The results of the query are returned back to the VOD presentation formatter.

The search results are structured dynamically by the VOD presentation formatter into an HTML page which is transmitted and returned to the client, apparently via the client web browser 221. The steps set forth above, Day '015 patent column 5, lines 7-29, are repeated as necessary to narrow the search.

However, the selection method executed in the system present in the Day '015 patent is always exactly the same. All of the elements perform the same operations. It is only the user when he or she either selects the search function or completes the search field that a change is made. The selection method executed is still the same. The preferences of the user are not incorporated into the selection method. But the selection method takes into account those parameters that are put into it whether or not they are preferences of the user.

This is in distinction to Applicant's system where the selection method makes record of the user's preferences and consequently biases the data streams by updating the selection method in order to better reflect the preferences of the user. One advantageous feature of Applicant's system is that new material can be incorporated into the database of data streams and still be subject to the selection method and possibly provide new material that meets the criteria of the user's expressed preferences.

No such making of record of the user's preference is present in the Day '015 patent. As a result, the selection method is not updated, but always operates the same. The only updating that occurs in the Day '015 system is the experience of the user (not the system) in being able to better select criteria according to either the search function or the search field. The historical memory of the user in the Day '015 patent is outside the scope of the system set forth there. No algorithm, method, routine, or process is set forth in the Day '015 patent that

alters the selection method according to the preferences of the user. The selection process is always the same in the Day patent, while it is dynamic in Applicant's claims.

Office action, paragraph 3, bullet 6

The Examiner relied upon lines 7-52 of column 5 in the Day '015 patent for having data streams transmitted to the user which are biased according to said preference.

The data streams are ones that are selected by the user, by the client according to column 5, line 30. As a result, there is generally no biasing according to the selection method. The selection method is basically a generation of search results that do not incorporate any residual information between search queries. Consequently, it is not the selection method of the Day '051 patent that biases the transmission of data streams, but it is the user him or herself. This generally makes the Day '015 patent an enhanced video on demand system (VOD system) as set forth in column 4, the paragraph beginning on line 42 thereof.

There is no disclosure in the Day '015 patent with regards to the format or content of the data stream. No indication by the viewer of preferred formats is set forth in column 5. Instead, all of the search results generation set forth in column 5 (in the paragraph beginning on line 7) are for the client to select an asset and an asset only. No indication whatsoever is given with respect to format information or compatibility between media streams in a database and the available player on a user's system. Instead, all of these are apparently assumed not to be compatible by the disclosure set forth in the Day '015 patent.

As a result, if a user is interested in movies by Meg Ryan, and such a searchable field is present in the application server content management database 217, the VOD formatter may create a search form based upon "artist" if that field is so present in the database 217, for

example. The client, completing the search field with the string "Meg Ryan" or similar can then send the data to the presentation formatter server 207 which receives the request and runs the VOD presentation formatter program. The query is then passed on to the application server portion 209 of the controller which in turn queries the content management database. The results of the search upon the string "Meg Ryan" would then be returned back to the VOD presentation formatter which then dynamically builds an HTML page and returns the page containing the search results to the client.

Apparently, a list of movies which include Meg Ryan as an artist would be one possible result of the client's activities. The client can then select one of more of the presented Meg Ryan movies.

It is in the realm of conceivable possibility that the dynamic search form based upon the fields in the application server content management database 217 include format data with respect to the formatting of the data stream. And this might be a field upon which a client can search. However, the inclusion of format data does not generally change the selection method as the selection method remains the same in that there will be a test as to whether or not the client has entered format data and if so, one thing occurs and if not, something else occurs but the method stays the same. It is simply a method that incorporates these two possibilities.

This is in distinction with respect to Applicant's system which not only just takes into account the expressed preferences of the user, but actually updates the selection method by having a parameter file that affects the results of the search in selecting data streams to transmit from the database to the user. No such indication is present in the Day '015 patent that the user has expressed a preference with respect to either Meg Ryan movies or

QuickTime™ format or otherwise. These all have to be entered by the user every single time in order to achieve the client's ends in the Day '015 patent.

With respect to the "commonization process" of the Day patent in column 6 in the paragraph beginning at line 9, it is not the expressed preference of the client, but an inspection of the client's selections that determine the generation of videos having the same operating characteristics. The client's selections only express preferences regarding content, not format, or are ambiguous and do not teach or disclose expressed preferences regarding format. In any case, such selections are not "feedback."

As a result, the Day '015 patent discloses subject matter separate and apart from that which is disclosed by Applicant and which is outside the scope of Applicant's claims. In any case, all that the commonization process does is lead to the generation of a video stream that comports with the general tendencies indicated by the formats of video selected by the client. This in no way changes the selection method, or enables it to be updated, as it is still the client-selected list that is transmitted to the client. In general, the selection process is one that is client-based, and not system or method-based.

Additionally, the selection method in the Day '015 patent does not change any more than any other search engine changes. Such search engines take input from users or otherwise and return the results based upon the database. No account is taken, generally, of prior searches and such search engines generate links to assets, and generally do not provide the assets themselves in any sort of playlist or list. Indeed, it would be rather odd if after running a Google™ search, all of the possibly tens of thousands of web pages were then transmitted to the user's computer or queued up for the same.

As a result, and due to the forgoing, Applicant believes that the Day '015 patent cannot reasonably be read to teach or describe each and every element or claim limitation in Applicant's claims 1, 11, 12, 21, 24, 25, 36 and 46. Applicant believes this is particularly true for Applicant's broadest claims, the independent claims, claims 1, 11, 21, 24, 35, and 46. No feedback is present in the Day '015 patent with respect to the transmission of data streams from a database. If web streams are being considered as data streams by the Examiner, the expressed preferences are not applicable to those web pages. If the database in the Day '015 patent is a database of videos or the like, no indication is given with regards to feedback regarding those assets. The Examiner has indicated only the interaction of the client with the search engine, something outside the scope of Applicant's claims.

As Applicant's broadest and independent claims are believed not to be anticipated by the Day '015 patent, Applicant believes that the remaining dependent claims are likewise not anticipated by that reference.

The Rejections - § 103

For the same reasons, Applicant believes that the claim rejections based on 35 U.S.C. § 103 are also overcome. The elements necessary for a rejection based on obviousness are not present in the Day '015 patent nor are they present when the Day '015 patent is taken in combination with any of the other references. The forgoing arguments are incorporated herein by reference thereto and the Federal Circuit has recently spoken with respect to the combination of references in order to achieve a valid rejection based on obviousness.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the

present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the user-biased selection method claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner has been unable to reconstruct from the cited references a streaming media selection method which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element

of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in combination, disclose or suggest the combination of elements recited in Applicant's present claims. As such, Applicant's Claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. A reading of each of the references uncovers no suggestion or teaching in any of them as to the advantages to be gained by having a streaming media selection and broadcast method that provides each user with a preference-biased data stream as only a search engine based video on demand (VOD) system is disclosed in Day '015 and the shortcomings in this Day patent are not remedied by teachings in the other references cited. The Examiner cannot pull from the cited references specific elements claimed by Applicant, based on Applicant's own teaching, but must rely on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entirety, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Thus, it is clear that, in light of decisions of the CAFC, rejections based on obviousness cannot meet the CAFC's tests in combining references in light of the cited references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS

Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). No piecemeal construction of the prior art in view of the Applicant's own disclosure can be made in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art"

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in any of the cited

references relied on by the Examiner from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination. . .

. It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicant's claims are believed to be patentable over any and all of the cited references, taken alone or in any reasonable combination.

Even in light of the Manual of Patent Examining Procedure (MPEP), particularly § 2143.01, a suggestion or motivation must be present in order to combine references for purposes of obviousness.

Importantly, the prior art must suggest the desirability of the claimed invention.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of

obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the patent claimed underpinning a slumping building foundation using a screw anchor attached to

the foundation by a metal bracket. One prior art reference taught a screw anchor with a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed “to precisely the same problem of underpinning slumping foundations.” Id. at 1276, 69 USPQ2d at 1690. The court also rejected the notion that “an express written motivation to combine must appear in prior art references....” Id. at 1276, 69 USPQ2d at 1690. However, it is apparent in Ruiz that a motivation to combine must still be present.

In In re Kotzab, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a “technologically simple concept,” there was no finding “as to the specific understanding or principle within the knowledge of the skilled artisan” that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In In re Fine, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph,

combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

In In re Jones, the claimed invention was the 2-(2C-aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed inter alia the substituted ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

Also, where the teachings of the prior art conflict, the examiner must weigh the suggestive power of each reference.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991) (Prior art patent to Carlisle disclosed controlling and minimizing bubble oscillation for chemical explosives used in marine seismic exploration by spacing seismic sources close enough to allow the bubbles to intersect before reaching their maximum radius so the

secondary pressure pulse was reduced. An article published several years later by Knudsen opined that the Carlisle technique does not yield appreciable improvement in bubble oscillation suppression. However, the article did not test the Carlisle technique under comparable conditions because Knudsen did not use Carlisle's spacing or seismic source. Furthermore, where the Knudsen model most closely approximated the patent technique there was a 30% reduction of the secondary pressure pulse. On these facts, the court found that the Knudsen article would not have deterred one of ordinary skill in the art from using the Carlisle patent teachings.).

The fact that references can be combined or modified is not sufficient to establish prima facie obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir.

1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness.

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both

the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function.” In re Dance, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a “means for recovering fluid and debris” in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.).

The proposed modification cannot change the principle of operation of a reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.).

As the cited references neither indicate the problem of microcasting or narrowcasting, none can teach Applicant's solution. The same is likewise similar and there is no teaching of Applicant's claims as the cited references do not disclose the elements necessary to achieve the subject matter of Applicant's claims.

Lastly, the Court of Appeals for the Federal Circuit has made clear that hindsight reconstruction cannot be used to reject a claim and that the Examiner must show the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In reversing both the Board and the Examiner in their rejection of the claims, the Dembiczak Court made clear that the best defense against the subtle but powerful attraction of

a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). See also Graham v. John Deere, 383 U.S. at 18, 148 USPQ at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”). In the Dembiczak case, above, the Board fell into the hindsight trap.

The Dembiczak court noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although “the suggestion more often comes from the teachings of the pertinent references,” Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (“Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.”); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) (“The examiner’s conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection.”). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. In Dembiczak, however, the Board did not

make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

As in the examination proceedings in Dembiczak, the Examiner has fallen into the insidious trap of hindsight reconstruction and has found no motivation or teaching for combining the references.

In In re Dembiczak, the applicants claimed a large, orange plastic trash bag decorated with a jack-o'-lantern face. The PTO rejected the claims as prima facie obvious based on prior art references showing (1) conventional trash bags, and (2) "children's art" with jack-o'-lantern faces on the outside of paper sacks (Holiday and Shapiro). The court reversed because the PTO's broad conclusory statements regarding the teaching of multiple references, standing alone, were not "actual evidence" supporting a suggestion to combine.

"All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. ... To justify this combination, the Board simply stated that 'the Holiday and Shapiro references would have suggested the application of ... facial indicia to the prior art plastic trash bags. ... However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other--in combination with each other and the conventional trash bags--described all of the limitations of the pending claims. ... Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

"To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday

bag reference depicts a 'premanufactured orange' bag material, ... finds that Shapiro teaches the use of paper bags in various sizes, including 'large', ... and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice. ... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet ... (noting Board's failure to explain, when analyzing the prior art, 'what specific understanding or technical principle ... would have suggested the combination'). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand.'

175 F.3d at 1000, 50 USPQ2d at 1617-18 (emphasis added).

The Examiner has also cited a number of patents and publications as pertinent to the presently claimed invention. Since none of these have been relied upon as a reference against Applicant's claims, no further comment is deemed necessary.

In view of the above, the Examiner is respectfully requested to reconsider her position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

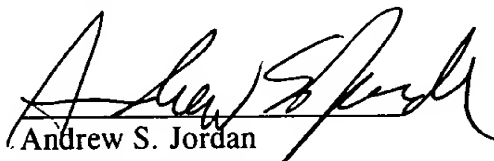
If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to allowance.

It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP


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Tel.: (310) 451-0647 x125

Date: July 15, 2004

ASJ/kef

Enclosures

Exhibit 1
Petition for Extension of Time- 1 month
Acknowledgement Postcard

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Main Entry: **feed·back** 

Pronunciation: ' fEd - "bak

Function: *noun*

1 : the return to the input of a part of the output of a machine, system, or process (as for producing changes in an electronic circuit that improve performance or in an automatic control device that provide self-corrective action)

2 a : the partial reversion of the effects of a process to its source or to a preceding stage **b** : the transmission of evaluative or corrective information to the original or controlling source about an action, event, or process; *also* : the information so transmitted

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